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PATENT APPLICATION

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re the Application of

Josep Vicent MERCADER BADIA et al. Group Art Unit: 1657

Application No.: 10/551,989 Examiner: L. HOBBS

Filed: October 4, 2005 Docket No.: 125291

For: METHOD FOR DETECTING AND/OR IDENTIFYING BACTERIA PRESENT IN A SAMPLE

RESPONSE TO RESTRICTION REQUIREMENT

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

In reply to the January 9, 2008 Restriction Requirement, Applicants provisionally elect Group I, claims 1-5 and 11, with traverse.

National stage applications filed under 35 U.S.C. §371 are subject to unity of invention practice as set forth in PCT Rule 13, and are not subject to U.S. restriction practice. *See* MPEP §1893.03(d). PCT Rule 13.1 provides that an "international application shall relate to one invention only or to a group of inventions so linked as to form a single general inventive concept." PCT Rule 13.2 states:

> Where a group of inventions is claimed in one and the same international application, the requirement of unity of invention referred to in Rule 13.1 shall be fulfilled only when there is a technical relationship among those inventions involving one or more of the same or corresponding special technical features. The expression "special technical features" shall mean those technical features that define a contribution which each of the claimed inventions, considered as a whole, makes over the prior art.

A lack of unity of invention may be apparent "*a priori*," that is, before considering the claims in relation to any prior art, or may only become apparent "*a posteriori*," that is, after taking the prior art into consideration. *See* MPEP §1850(II), quoting *International Search and Preliminary Examination Guidelines* ("ISPE") 10.03. Lack of *a priori* unity of invention only exists if there is no subject matter common to all claims. *Id.* If *a priori* unity of invention exists between the claims, or, in other words, if there is subject matter common to all the claims, a lack of unity of invention may only be established *a posteriori* by showing that the common subject matter does not define a contribution over the prior art. *Id.*

Page 2 of the Office Action states that the two sets of method claims directed to detecting bacteria are applied to two different devices, and that the apparatus claims recite a separate device for detecting bacteria, but which is not adapted to perform either of the methods. This analysis fails to discuss any of the special technical features (i.e., features that define a contribution which each of the claimed inventions, considered as a whole, make over the prior art) of independent claims 1, 6 and 7 because it only discusses different devices that are capable of detecting bacteria. Because the method can be performed with different devices does not mean that there is no subject matter that is common to independent claims 1, 6 and 7.

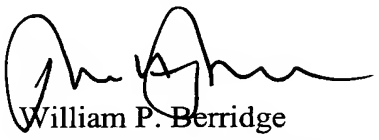
Applicants assert that independent claims 1, 6 and 7 share common subject matter and, therefore, *a priori* unity of invention exists between all the claims. Thus, for the present application, a lack of unity of invention may only be determined *a posteriori*, or in other words, after a search of the prior art has been conducted and it is established that all the elements of the independent claim are known. *See* ISPE 10.07 and 10.08.

The Office Action does not establish that each and every element of the subject matter that is common to independent claims 1, 6 and 7 is known in the prior art. Therefore, Applicants respectfully submit that lack of unity of invention has not been established, and

thus a restriction requirement based on a lack of unity of invention is improper.

Thus, withdrawal of the Restriction Requirement is respectfully requested.

Respectfully submitted,



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WPB/RHR

Date: January 25, 2008

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